

# Interview Summary

Application No.  
09/123,620

Applicant(s)  
Elford

Examiner  
Kathleen Kahler Fonda

Group Art Unit  
1623



All participants (applicant, applicant's representative, PTO personnel):

(1) Kathleen Kahler Fonda (3) \_\_\_\_\_  
(2) James Rowe (4) \_\_\_\_\_

Date of Interview 12-23-99

Type: ☒ Telephonic ☐ Personal (copy is given to ☐ applicant ☐ applicant's representative).

Exhibit shown or demonstration conducted: ☐ Yes ☒ No. If yes, brief description:

Agreement ☐ was reached. ☒ was not reached.

Claim(s) discussed: all of record

Identification of prior art discussed:

none

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:

Dr. Rowe was informed that the after final amendment of 11-18-99 had been received but would not be entered. An advisory action will be mailed. The examiner will grant an interview after the first of the year if Dr. Rowe decides to request one.

Ref BS on the IDS of 11-18-99 has been considered, but cannot be listed on the face of any patent which may issue from this application unless Applicant provides a publication date.

(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

1. ☒ It is not necessary for applicant to provide a separate record of the substance of the interview.

Unless the paragraph above has been checked to indicate to the contrary, A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a response to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW.

2. ☐ Since the Examiner's interview summary above (including any attachments) reflects a complete response to each of the objections, rejections and requirements that may be present in the last Office action, and since the claims are now allowable, this completed form is considered to fulfill the response requirements of the last Office action. Applicant is not relieved from providing a separate record of the interview unless box 1 above is also checked.

KATHLEEN KAHLER FONDA  
PRIMARY EXAMINER  
ART UNIT 1623

Examiner Note: You must sign and stamp this form unless it is an attachment to a signed Office action.

Art Unit: 1623

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Any objection or rejection made in a previous Office action and not repeated herein is withdrawn in view of Applicant's arguments and/or amendments.

Claim 2 is objected to as informal because in lines 7-8, "O-pheny" should be --O-phenyl--.

Claims 4 and 8 are again objected to, as set forth in the Office action of 05-25-99, under 37 CFR 1.75 as being substantial duplicates of claim 1. Applicant's arguments filed 07-19-99 have been fully considered but they are not persuasive. Applicant argues that there are free radical scavengers and RBI's other than those covered by the formula of claim 1. While this may be correct, the argument is unpersuasive because both claims 4 and 8 clearly are limited to the NF- $\kappa$ B inhibitor of claim 1 which is shown in the formula.

Claims 9-11 are again rejected, as set forth in the Office action of 05-25-99, under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one

Art Unit: 1623

skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has failed to address this rejection. Note that because claims 9-11 are originally filed claims, this rejection may be overcome by amending the specification to recite the omitted subject matter. Note also that the Examiner has withdrawn the rejection under 35 U.S.C. 112, second paragraph, regarding this language.

Claims 1-11 are again rejected, as set forth in the Office action of 05-25-99, under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 1 remains indefinite because the phrase "NF-kB inhibiting amount" has no particular art-recognized meaning and has not been adequately defined in the specification as filed. Applicant's arguments filed 07-19-99 have been fully considered but they are not persuasive. Applicant argues that the amount is determined experimentally and that numerous patents employ such terminology. These arguments are not persuasive because, as stated, the specification defined the phrase, either in terms of appropriate experiments or otherwise. Furthermore, it is well

Art Unit: 1623

settled that whether similar claims have been allowed to others is immaterial (*In re Giolito* 188 USPQ 645 (1976)).

Claim 1 is still indefinite for failing to claim that which Applicant considers to be the invention. The term "and" in lines 8 and 9 would appear to indicate that salts and phenol derivatives must be administered together with a compound having the cited formula. Applicant's arguments filed 07-19-99 have been fully considered but they are not persuasive. Applicant states that the language is believed to be unambiguous, and is commonly employed. The latter argument has been addressed above. As to the former, if Applicant states on the record that the process of claim 1 requires administration of all three of the drug, a salt thereof, and an acylated phenol derivative thereof, this rejection will be withdrawn, and the prior art reevaluated in light of this significant limitation.

Claim 2 remains indefinite because the phrase "includes, but is not limited to" at lines 2-3 does not provide any limitation to the claim. Applicant's arguments filed 07-19-99 have been fully considered but they are not persuasive. Applicant states that other external agencies are intended to be covered by the claim. Therefore, the Examiner suggests replacing "includes, but is not limited to," with --comprises--.

Art Unit: 1623

Claims 1-11 are again rejected, as set forth in the Office action of 05-25-99, under 35 U.S.C. 103(a) as being unpatentable over VAN'T RIET et al. (A) in view of Applicant's admission.

Applicant's arguments filed 07-19-99 have been fully considered but they are not persuasive. Applicant argues that the Examiner's rejection was based on hindsight, and that there is no reason other than Applicant's disclosure to believe the compounds of the claims to be anti-oxidants. In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. However, as long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, the necessary knowledge clearly was not gleaned from Applicant's disclosure. The VAN'T RIET abstract had disclosed that the same compounds as those of Applicant's claim 1 were ribonucleotide reductase inhibitors and free radical scavengers. Based on well-known elementary chemical principles, any compound which inhibits a reductase clearly keeps the reductase from being oxidized, and is therefore an anti-oxidant.

Art Unit: 1623

Similarly, free radicals are known to be oxidizing agents. Therefore, a compound that acts as a free radical scavenger prevents free radicals from causing oxidation, and is an anti-oxidant. Applicant's discussion of anti-oxidants in terms of peroxides is certainly too narrow an interpretation of the term.

No claim is allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Papers relating to this application may be submitted to Technology Center 1600 by facsimile transmission. The number of

Art Unit: 1623

the fax machine for official papers in Technology Center 1600 is (703) 308-4556. Any document submitted by facsimile transmission will be considered an official communication unless the cover sheet clearly indicates that it is an informal communication.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kathleen Kahler Fonda, at telephone number (703) 308-1620. Examiner Fonda can generally be reached from Tuesday through Friday, as well as on alternate Mondays, between 7:30 a.m. and 5:00 p.m. If the Examiner cannot be reached, questions may be addressed to Supervisory Patent Examiner Gary Jones at (703) 308-1152, or to Special Programs Examiner Cecilia Tsang at (703) 308-0254. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-1235.



Kathleen Kahler Fonda, Ph.D.  
Primary Examiner  
Art Unit 1623